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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/782,873  | 02/10/2001  | Gregory J. Petras    | WC01520             | 6566             |
| 28548   | 7590        | 11/18/2005           | EXAMINER            |                  |
| STONEMAN LAW OFFICES, LTD<br>3113 NORTH 3RD STREET<br>PHOENIX, AZ 85012 |             |                      | ALAM, SHAHID AL     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2162                |                  |
| DATE MAILED: 11/18/2005   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/782,873

Applicant(s)

PETRAS ET AL.

Examiner

Shahid Al Alam

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 - 41 is/are pending in the application.
- 4a) Of the above claim(s) 12-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05102001</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### Response to Applicant's Request for Reconsideration of Election/Restriction Requirements

1. Applicant's election with traverse of Group I (claims 1 – 11) in the reply filed on September 26, 2005 is acknowledged.

Applicant argues that according to MPBP 803, "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." In the present case, the claims in each of the groups identified by the Examiner, clearly comprise similar elements and would not place undue burden on the examiner. In view of these matters, it is respectfully requested that the restriction requirement be withdrawn and that each of the claims presently pending in this application be examined. This is not found persuasive for the reasons set forth hereinbelow:

With reference to **"Related Inventions"**, MPEP 808.02 states:

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (MPEP 806.05). If applicant optionally restricts, double patenting may be held. **Where the related inventions as claimed are shown to be distinct under the criteria of MPEP 806.05(c) - 806.05 (i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:**

Art Unit: 2162

(A) Separate classification thereof: This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) A separate status in the art when they are classifiable together: Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) A different field of search: Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.

The examiner has fulfilled his duties by providing appropriate explanation as to how the related inventions of Groups I through IV are distinct **under the criteria of MPEP: 806.05(c) - 806.05(i)**. Please see the highlighted sections:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 - 11, drawn to a system for **creating and maintaining information in a database of subjects using a plurality of natural language terms and rating the degree of relevance of each of such natural language terms, classified in class 704, subclass 9.**
- II. Claims 12, 13 and 35 – 41, drawn to **an Internet website client-server computer system to determine a level of subjects and degree of relevance, classified in class 707, subclass 10.**
- III. Claims 14 – 29, drawn to **a business system to manage the direct collection of sponsor revenue, classified in class 705, subclass 51.**
- IV. Claims 30 – 34, drawn to **a searchable database of defined categories of subjects having interface processing means for assisting user to choose from plurality of terms, classified in class 707, subclass 4.**

The inventions are distinct, each from the other because of the following reasons:

Inventions listed as Group I, Group II, Group III and Group IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention has separate utility such as follow.

Group I: A system for creating and maintaining information in a database of subjects using a plurality of natural language terms and rating the degree of relevance of each of such natural language terms.

Group II: An Internet website client-server computer system to determine a level of subjects and degree of relevance.

Group III: A business system to manage the direct collection of sponsor revenue.

Group IV: A searchable database of defined categories of subjects having interface processing means for assisting user to choose from plurality of terms  
See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III and IV, the search required for Group II is not required for Groups I, III and IV, the search required for Group III is not required for Groups I, II and IV, and the search required for Group IV is not required for Groups I, II and III, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Besides that requiring an examiner does not seem to be in conformance with two well known Patent Goals outlined in the published Strategic Plan of the U. S. Patent and Trademark Office, available to the general public at [www.uspto.gov](http://www.uspto.gov). **The purpose of these goals is an efficient and streamlined patent process to reduce the cycle**

**time and improve the quality of a patent issued.** The common sense is also that searching in limited and appropriate areas would turn out a prior art reference faster and thus help close the prosecution of a case earlier.

So in view of the above mentioned MPEP sections and in the spirit of fulfilling stated Patent Goals, the examiner respectfully submits that, the requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,330,576 issued to Takatoshi Mochizuki et al. ("Mochizuki") and in view of U.S. Patent Number 6,026,388 issued to Elizabeth Liddy et al. ("Liddy").

With respect to claim 1, Mochizuki discloses a system for creating and maintaining information in a database of subjects, available to a population of users (column 2, lines 50 – 54), comprising:

a) describing a database subject using a plurality of natural-language terms, each of such plurality of natural-language terms having relevance to the subject according to an involved subset of such population of users (column 3, lines 21 – 32);

b) rating the degree of relevance of each of such plurality of natural-language terms to such database subject according to each of such involved subset of such population of users (column 8 (lines 31 – 35);

c) associating, in such database, such respective natural-language terms and respective degrees of relevance with each such database subject (column 7, lines 28 – 35).

With respect to claim 1, Mochizuki does not explicitly teach computing for users in database an overall degree of relevance of each of plurality of terms to database subject as claimed.

Liddy discloses claimed computing for users in database an overall degree of relevance of each of plurality of terms to database subject (column 2, lines 61 – 67; column 8, lines 41 – 47 and column 25, lines 14 – 20).



It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine Liddy's natural language information retrieval system with Mochizuki's teachings of degrees of similarity or relevancy because the combination would provide techniques for generating sophisticated representations of the contents of both the queries and documents in a retrieval system by using natural language processing techniques and offers the ability to interact with the system to confirm and refine the systems interpretation of the query content, both at an initial query processing step and after query matching has occurred (see column 2, lines 35 – 45; Liddy).

***Allowable Subject Matter***


3. Claims 2, 3, 6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 4, 5, 7 and 9 –11 are dependent on above objected (allowable) claims and these claims being definite, further limiting, and fully enabled by the specification could also be allowed.

***Contact Information***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Al Alam whose telephone number is (571) 272-4030. The examiner can normally be reached on Monday-Thursday 8:00 A.M.- 4:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Shahid Al Alam  
Primary Examiner  
Art Unit 2162

13 November 2005